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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,039	05/03/2006	Tohru Kanegae	8048-1101	7901
<div>465 7590 06/10/2010</div> <div>YOUNG &amp; THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314</div>				
EXAMINER				
TEKLE, DANIEL T				
ART UNIT		PAPER NUMBER		
2621				
NOTIFICATION DATE		DELIVERY MODE		
06/10/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

### Office Action Summary

**Application No.**

10/530,039

**Applicant(s)**

KANEGAE ET AL.

**Examiner**

DANIEL TEKLE

**Art Unit**

2621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 22-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 22-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/GS/US)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claim 43-45** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. The claim recites, *inter alia*, "A computer readable storage medium having a computer readable program stored thereon that is ..." After close inspection, the Examiner respectfully notes that the disclosure, as a whole, does not specifically identify what may be included as a computer readable storage medium and what is not to be included as a computer readable storage medium.

4. An Examiner is obliged to give claims their broadest reasonable interpretation consistent with the specification during examination. The broadest reasonable interpretation of a claim drawn to a computer readable medium (also called machine readable medium and other such variations) typically covers forms of non-transitory tangible media and transitory propagating signals *per se* in view of the ordinary and customary meaning of computer readable media, particularly when the specification is silent. See MPEP 2111.01. When the broadest reasonable interpretation of a claim covers a signal, *per se*, the claim must be rejected under 35 U.S.C. § 101 as covering non-statutory subject matter.

5. Therefore, given the silence of the disclosure and the broadest reasonable interpretation, the computer readable storage medium of the claim may include

transitory propagating signals. As a result, the claim pertains to non-statutory subject matter.

6. However, the Examiner respectfully submits a claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation "non-transitory" to the claim. Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*. For additional information, please see the Patents' Official Gazette notice published February 23, 2010 (1351 OG 212).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-36 and 39-45 rejected under 35 U.S.C. 102(e) as being anticipated by Ninomiya (US 20020090197).

**Regarding Claim 22:** Ninomiya discloses an information record medium, which can be recorded by an information recording apparatus or which can be reproduce by an

information reproducing apparatus, on which there are recorded: a plurality of content in formations (**paragraph 0059**); and a plurality of first in formations each indicating a plurality of play list in formations each defining reproduction sequence of one part of the plurality of content information (**paragraph 0061 and fig. 5**), wherein some of plurality of content information, are different from each other in reproduction functions required for an information reproduction system to reproduce the plurality of content information and are adapted to at least partially construct title which is a logically united information united information unit (**paragraph 0064**), reproduction sequence of said some of the plurality of content information are defined by the plurality of play list information indicated by one of the first information (**paragraph 0061-0062 and fig. 5**).

**Regarding Claim 23:** Ninomiya discloses an information record medium according to claim 22, wherein required function information indicating the reproduction function is further recorded for each of the plurality of play list information (**paragraph 0083**).

**Regarding Claim 24:** Ninomiya discloses an information record medium according to claim 22, wherein the plurality of content information include video information and audio information, and the reproduction function is a video reproduction performance and an audio reproduction performance required for the information reproduction system (**Fig. 2a-2b**).

**Regarding Claim 25:** Ninomiya discloses an information record medium according to claim 24, wherein the required function information is of information, which indicates

the video reproduction performance and the audio reproduction performance and is recorded for each of the plurality of play list information (**paragraph 0049-0050**).

**Regarding Claim 26:** Ninomiya discloses an information record medium according to claim 25, wherein priority information indicating which of the video reproduction performance and the audio reproduction performance is to be prioritized is further recorded (**paragraph 0074**).

**Regarding Claim 29:** Ninomiya discloses an information record medium according to claim 22, wherein each of the play list information includes pointer information designating item information, which is a logically accessible reproduction unit and composes the content information (**paragraph 0055**).

**Regarding Claim 30:** Ninomiya discloses an information record medium according to claim 22, wherein title information designating at least one first information from among the plurality of first information which corresponds to the content information to be reproduced, is further recorded to reproduce the plurality of content information as the title (**paragraph 0064**).

**Regarding Claim 31:** Ninomiya discloses an information record medium according to claim 30~ wherein the title information includes pointer information designating at least one first information, which corresponds to the content information to be reproduced (**paragraph 0055**).

**Regarding Claim 32:** Ninomiya discloses an information record medium according to claim 22, wherein a whole stream including a plurality of partial streams made of the

plurality of content information is multiplexed by a packet unit which is a physically accessible unit and stores pieces of the plurality of content information and relationship definition information defining a relationship between packets to be multiplexed and the plurality of partial streams is further recorded, as reproduction control information to control a reproduction of the plurality of content information (**paragraph 0049-0050**).

**Regarding Claim 33-34:** Claim 33-34 reject for the same reason to claim 22 and 23 respectively as discussed above.

**Regarding Claim 35-36:** Claim 35-36 reject for the same reason to claim 22 and 23 respectively as discussed above.

**Regarding Claim 37:** Ninomiya discloses an information reproduction apparatus for reproducing the information record medium according to claim 22, said apparatus comprising: a reproduction device capable of reproducing the plurality of content information, first information and the play list information (**paragraph 0059 and fig. 5**); and a control device for selecting one play list information, from among plurality of play list information indicated by one of the first information and controlling the reproduction device to reproduce the content information in accordance with the selected play list information (**paragraph 0061 and fig. 5**).

**Regarding Claim 38:** Claim 38 reject for the same reason to claim 24 as discussed above.

**Regarding Claim 39:** Ninomiya discloses an information reproduction apparatus for reproducing the information record medium according to claim 23, apparatus

comprising: a reproduction device capable of reproducing the plurality of content information, the plurality of first information and the required function information (**paragraph 0061**); and a control device for selecting one play list information defining the reproduction sequence of the content information reproducible by the information reproduction apparatus, from among the plurality of play list information indicated by one of the first information by comparing ( i ) the reproduction function indicated by the required function information reproduced by the reproduction device with (ii) reproduction function of the information reproduction apparatus indicated by a set function information set for the information reproduction apparatus, and controlling the reproduction device to reproduce the content information in accordance with the reproduction sequence defined by the selected play list information (**paragraph 0061 and fig. 5**).

**Regarding Claim 40:** Ninomiya discloses an information reproduction apparatus according to claim 39, wherein the plurality of content information includes video information and audio information, the reproduction function is a video reproduction performance and an audio reproduction performance required for the information reproduction system, the required function information is of information indicating the video reproduction performance and the audio reproduction performance recorded for each of the plurality of play list information, the set function information indicates the video reproduction performance and the audio reproduction performance of the information reproduction apparatus, and the set function information includes information indicating whether or not the information reproduction apparatus has



different video reproduction performances for each of predetermined ranks and information indicating whether or not the information reproduction apparatus has different audio reproduction performances for each of predetermined ranks (**paragraph 0061 and fig. 2a-2b**)

**Regarding Claim 41:** Ninomiya discloses an information reproduction apparatus for reproducing the information record medium according to claim 26, said apparatus comprising: a reproduction device capable of reproducing the plurality of content information, the plurality of first information and the required function information (**paragraph 0061**); and a control device for selecting one play list information defining the reproduction sequence of the content information reproducible by the information reproduction apparatus, from among the plurality of play list information indicated by one of the first information by comparing (i) the video reproduction function and the audio reproduction function indicated by the required function information reproduced by the reproduction device with (ii) video reproduction function and audio reproduction function of the information reproduction apparatus indicated by a set function information set for the information reproduction apparatus, and controlling the reproduction device to reproduce the content information in accordance with the reproduction sequence defined by the selected play list information wherein the control device selects one play list information corresponding to the vide reproduction performance or the audio reproduction performance prioritized in accordance with the priority information, from among the plurality of play list information included in the same play list (**paragraph 0061 and fig. 2a-2b**).

**Regarding Claim 42:** Ninomiya discloses an information reproduction method of reproducing the information record medium according to claim 22, said method implemented with an information reproduction apparatus comprising a reproduction, device capable of reproducing the plurality of content information and the first information and the play list information, said method comprising: a first control process of selecting one play list information from among the plurality of play list information indicated by one of the first information and a second controlling process of controlling the reproduction device to reproduce the content information in accordance with the selected play list information (**paragraph 0061 and fig. 5**).

**Regarding Claim 43-44:** Claim 43-44 reject for the same reason to claim 33 and 37 respectively as discussed above.

**Regarding Claim 45:** Claim 45 reject for the same reason to claim 1 as discussed above.

**Regarding Claim 27-28:** Claims 27 and 28 are objected due there dependence to claim 24 and 27 respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL TEKLE whose telephone number is (571)270-1117. The examiner can normally be reached on 7:30am to 5:00pm M-R and 7:30-4:00 Every other Friday..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha D. Banks-Harold can be reached on 571-272-7905. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Marsha D. Banks-Harold/  
Supervisory Patent Examiner, Art Unit 2621

/Daniel Tekle/  
Examiner, Art Unit 2621

